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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/189,574 11/11/98 DUBRUL

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EXAMINER

QM12/1014

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ART UNIT

PAPER NUMBER

3731

DATE MAILED:

10/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/189,574

Applicant(s)

Dubrul et al.

Examiner  
Jonathan Goldberg

Group Art Unit  
3731



☒ Responsive to communication(s) filed on Nov 11, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner fails to see how engagement element can be of annular braided segments and one of the group claimed which includes an inflatable balloon. Applicant may wish to place the second limitation of claim 3 as a separate, dependent claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 4, 10, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevens et al. With regard to these claims, the illustrations of Stevens et al. disclose all the

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limitations comprising a catheter including: support wire (140), blocking mechanism (32), and engaging element (130). Note: With regard to functional language within these claims, the apparatus of Stevens et al. is capable of performing as claimed...which is not given great significance by examiner in apparatus claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al.

In view of Daniel et al. Stevens et al. discloses all the limitations of the claims except the malecot. Daniel et al. teaches of the malecot. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Daniel et al. to grant flexibility to an element for compact disposal.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. in view of Bates. Stevens et al. discloses all the limitations of the claim except the annular braided segments of blocking element and engaging element. Bates teaches of annular braided segments as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Bates to grant flexibility to an element for compact disposal.

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8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. and Daniel et al. in view of Bates. Stevens et al. and Daniel et al. disclose all the limitations of the claim including apparatus capable of performing as claimed. The examiner notes that illustrations of Bates teach of the engaging element contacting the wall as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Bates to serve as a trap.

9. Claims 6, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. in view of Daniel et al. Stevens et al. discloses all the limitations of the claims except the braided engaging element. Daniel et al. teaches of a braided engaging member with flexible yarns as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Daniel et al. to grant flexibility to an element for compact disposal.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. Stevens et al. disclose all the limitations of the claim including apparatus capable of performing as claimed. The examiner notes that apparatus of Stevens et al. is capable of performing as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Stevens et al. to capture a foreign body and dispose within.

11. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. in view of Daniel et al. Stevens et al. discloses a device capable of performing substantially as claimed except forcing the occlusion into the catheter, braided element, and the malecot. Daniel et al. teaches of an emboli capturing system, with braided element and malecot, capable of

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performing substantially as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Daniel et al. as a method by which a foreign body may be retained without risk of metastasis.

12. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. in view of Daniel et al. Stevens et al. discloses a device capable of performing substantially as claimed except the malecot. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Daniel et al. as a method by which a foreign body may be retained without risk of metastasis.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al. in view of Daniel et al. Stevens et al. discloses a device capable of performing substantially as claimed. Daniel et al. teaches of a method of emboli capturing substantially as claimed. Hence, it would be obvious to employ the teaching of Daniel et al. as a method by which a foreign body may be retained without risk of metastasis.

14. The courts have concluded that there is no requirement that a motivation to make the modification be expressly articulated by the prior art. The test for combining references is what the combination of disclosures takes as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Also, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

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*Allowable Subject Matter*

15. Claims 7-9, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lindenberg et al. discloses a device with many featured elements as claimed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan (Jon) Goldberg whose telephone number is (703) 308-0161. The examiner can normally be reached Monday through Friday from 8:00 AM to 3:00 PM (ET).

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 308-2708

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.



Jonathan D. Goldberg

10/8/99



MICHAEL BUIZ  
SUPERVISORY PATENT EXAMINER  
GROUP 3300

10/12/99